UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/522,525 | 11/01/2005 | David Dakin Iorwerth Wright | 07588.0080 | 7399 |

22852 7590 02/20/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

| EXAMINER | |
|---|---|
| GEORGE, KONATA M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1616 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/20/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/522,525 | WRIGHT ET AL. | |
| | Examiner | Art Unit | |
| | KONATA M. GEORGE | 1616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4,5,8,9,12-16,18-29,31,63-66,69-71,73-76 and 78-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,8,9,12-14,18-20,24-28,31,64-66,69-71,73,74,76,78,79 and 82* is/are rejected.

7)☒ Claim(s) *15,16,21-23,29,75,80 and 81* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Claims 1, 4, 5, 8, 9, 12-16, 18-29, 31, 63-66, 69-71, 73-76 and 78-82 are pending in this application.

### *Action Summary*

**The objection of claims 28 and 71 are hereby withdrawn in view of applicants' amendment to the claims.**

**The provisional rejection of claims 1, 4, 5, 8, 9, 12-14 and 18-20 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6-17 of copending application 10/522,527 is being maintained for the reasons stated in the office action dated July 5, 2007.**

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 5, 8, 9, 12-14 and 18-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6-17 of copending application No. 10/522,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a foam comprising a liquid phase containing at least one sclerosing agent and a gas phase comprising at least one physiologically acceptable gas. The difference between the two is the instant invention contains a viscosity-enhancing agent. The addition of a viscosity enhancing would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the claimed density and half-life of the foam.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant request that the examiner holds this rejection is abeyance until it is the remaining rejection. The examiner will grant this request.

**The provisional rejection of claims 1, 8, 18-20 and 24-27 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over**

**claims 1, 7, 10, 11, 12, 14 and 21 of copending application 10/890,267 is being maintained for the reasons stated in the office action dated July 5, 2007.**

Claims 1, 8, 18-20 and 24-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 11, 12, 14 and 21 of copending application No. 10/890,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a foam comprising a liquid phase containing at least one sclerosing agent and a gas phase comprising at least one physiologically acceptable gas. The difference between the two is the instant invention contains a viscosity-enhancing agent. The addition of a viscosity enhancing would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the claimed density and half-life of the foam.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant request that the examiner holds this rejection is abeyance until it is the remaining rejection. The examiner will grant this request.

**The provisional rejection of claims 1, 8, 9, 18-20, 26-28 and 31 on the grounds of nonstatutory obviousness-type double patenting as being**

**unpatentable over claims 1, 7-18, 33 and 35-40 of copending application 11/128,265 is being maintained for the reasons stated in the office action dated July 5, 2007.**

Claims 1, 8, 9, 18-20, 26-28 and 31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-18, 33 and 35-40 of copending application No. 11/128,265. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a foam comprising a liquid phase containing at least one sclerosing agent and a gas phase comprising at least one physiologically acceptable gas. The difference between the two is the instant invention contains a viscosity-enhancing agent. The addition of a viscosity enhancing would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the claimed density and half-life of the foam.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant request that the examiner holds this rejection is abeyance until it is the remaining rejection. The examiner will grant this request.

**The provisional rejection of claims 64-66, 69-71, 73, 74, 76, 78, 79 and 82 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 68, 69, 71, 74-76, 80-82, 87, 88, 91-94, 96, 97, 100-102 and 107 of copending application 11/171,293 is being maintained for the reasons stated in the office action dated July 5, 2007.**

Claims 64-66, 69-71, 73, 74, 76, 78, 79 and 82 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 68, 69, 71, 72, 74-76, 80-82, 87, 88, 91-94, 96, 97, 100-102 and 107 of copending application No. 11/171,293. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a method of producing a foam comprising passing a mixture of at least one sclerosing agent and at least one physiologically acceptable gas through a passage. The difference between the two is the cross-sectional dimensions of the passages as claimed in the instant invention. The determination of the cross-sectional dimensions would have been obvious to one of ordinary skill in the art as a means to formulate the foam in a consistency that would achieve the desired results of the clamed foam.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant request that the examiner holds this rejection is abeyance until it is the remaining rejection. The examiner will grant this request.

**The provisional rejection of claim 64 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending application 11/225,860 is being maintained for the reasons stated in the office action dated July 5, 2007.**

Claim 64 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending application No. 11/225,860. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a method of producing a foam comprising passing a mixture of at least one sclerosing agent and at least one physiologically acceptable gas through a passage having a cross-sectional dimension of from 0.1 to 30 microns, a density of between 0.07 g/mL to 0.19 g/mL and a half-life of at least 2 minutes. The difference between the copending applications is the ranges of the cross-sectional passages, density and half-life. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant request that the examiner holds this rejection is abeyance until it is the remaining rejection. The examiner will grant this request.

**The rejection of claims 64-66, 69, 70, 78, 79, 81 and 82 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 7, 18 and 19 of U.S. Patent No. 6,572,873 is hereby withdrawn in view of applicant amendment to the claims.**

**The rejection of claims 64-66, 69, 70, 78, 79 and 82 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7 and 8 of U.S. Patent No. 7,025,290 is hereby withdrawn in view of applicant amendment to the claims.**

**The rejection of claims 1, 13, 15, 18, 19, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over Cabrera Garrido et al. is hereby withdrawn in view of applicants' arguments.**

***Allowable Subject Matter***

Claims 16, 21-23, 75 and 80 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as stated in the office action dated July 5, 2007. Claims 15, 29 and 81 are also objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach, suggest or disclose the gas phases consisting essentially of $CO_2$ and $O_2$, the single injection concentration or the foam structure characteristics as described in claim 81.

***Conclusion***

Claims 1, 4, 5, 8, 9, 12-14, 18-20, 24-28, 31, 64-66, 69-71, 73, 74, 76, 78, 79 and 82 are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Konata M. George
Patent Examiner
Art Unit 1616

Johann R. Richter
Supervisory Patent Examiner
Art Unit 1616